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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,798	09/16/2003	Qinguo Fan	08387-009002	3486

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BOSTON, MA 02110

EXAMINER

FEELY, MICHAEL J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/664,798

Applicant(s)

FAN ET AL.

Examiner

Michael J. Feely

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>0903</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Double Patenting***

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 1-9 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-9 of prior U.S. Patent No. 6,646,026. This is a double patenting rejection. The following is a table showing corresponding claims:

<i>Instant Claim</i>	1	2	3	4	5	6	7	8	9
<i>Patent Claim</i>	1	2	3	4	5	6	7	8	9

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 10-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,646,026. Although

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the conflicting claims are not identical, they are not patentably distinct from each other because the article claims are an obvious result of the patented process. The following is a table showing corresponding claims:

<i>Instant Claim</i>	10	11	12	13	14	15	16	17	18	19
<i>Patent Claim</i>	1	2	3	4	5	6	7	8	9	1

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Soane et al. (US Pat. No. 6,607,994).

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Regarding claims 1-9, Soane et al. disclose: **(1)** a method of dyeing a polymer (column 1, line 48 through column 2, line 62; column 6, lines 45-67; column 10, lines 44-51), the method comprising dispersing a nano-material into the polymer to form a polymer nano-composite (column 1, line 48 through column 2, line 62; column 10, lines 44-51), and dyeing the polymer nano-composite with a dye (column 6, lines 45-67);

(2) wherein the polymer is *see claim for list* (column 10, lines 44-51);

(3) wherein the polymer is a polyolefin (column 10, lines 44-51); **(4)** wherein the polyolefin is polypropylene (column 10, lines 44-51);

(5) wherein the nano-material is nano-clay, nano-silica, metal oxide, zeolite, or nano-particles of a polymer (column 6, lines 45-67);

(6) wherein a nano-material is pretreated with a surfactant for improved compatibility with the polymer (column 10, line 65 through column 11, line 13);

(7) wherein a weight ratio of the nano-material to the polymer is in the range of 0.01-20% (column 11, lines 14-21);

(8) wherein the weight ratio of the nano-material to the polymer is in the range of 0.5-5% (column 11, lines 14-21); and

(9) wherein the nano-material is intercalated or exfoliated in the polymer (column 1, line 48 through column 2, lines 62).

Regarding claims 10-19, Soane et al. disclose: **(10)** a dyed polymer comprising a dye, a polymer, and a nano-material (column 1, line 48 through column 2, line 62; column 6, lines 45-67; column 10, lines 44-51), wherein the nano-material is dispersed in the polymer to form a

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polymer nano-composite (column 1, line 48 through column 2, line 62; column 10, lines 44-51), and the dye is linked to the nano-material (column 6, lines 45-67);

(11) wherein the polymer is *see claim for list* (column 10, lines 44-51);

(12) wherein the polymer is a polyolefin (column 10, lines 44-51); (13) wherein the polyolefin is polypropylene (column 10, lines 44-51);

(14) wherein the nano-material is nano-clay, nano-silica, metal oxide, zeolite, or nano-particles of a polymer (column 6, lines 45-67);

(15) wherein a nano-material is pretreated with a surfactant for improved compatibility with the polymer (column 10, line 65 through column 11, line 13);

(16) wherein a weight ratio of the nano-material to the polymer is in the range of 0.01-20% (column 11, lines 14-21);

(17) wherein the weight ratio of the nano-material to the polymer is in the range of 0.5-5% (column 11, lines 14-21);

(18) wherein the nano-material is intercalated or exfoliated in the polymer (column 1, line 48 through column 2, lines 62); and

(19) an article made of the dyed polymer of claim 10 (Abstract).

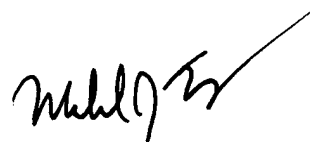
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Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Feely whose telephone number is 571-272-1086. The examiner can normally be reached on M-F 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michael J. Feely
Primary Examiner
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July 10, 2005